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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/492,697	01/27/00	DUJON	B 3495.0111-11

HM12/0212
Finnegan Henderson Farabow Garrett and D
1300 I Street N W
Washington DC 20005

EXAMINER

KAUSHAL, S

ART UNIT	PAPER NUMBER
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1633

DATE MAILED: 02/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/492,697

Applicant(s)

DUJON ET AL.

Examiner

Michael Wilson ?

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/05/00.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims ?

- 4) ☒ Claim(s) 23-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 23-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Applicant's response and the terminal disclaimer filed on 12/05/00 has been fully considered but are found unpersuasive for new grounds of restriction requirement below.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 23-37, drawn to a recombinant mammalian chromosome and cells comprising a Group I intron encoded endonuclease site (**I-SceI**), classified in class 435, subclass 325.
 - II. Claims 23-34, 36-37, drawn to a recombinant mammalian chromosome and cells comprising a Group I intron encoded endonuclease site (**I-SceIV**), classified in class 435, subclass 325.
 - III. Claims 23-34, 36-37, drawn to a recombinant mammalian chromosome and cells comprising a Group I intron encoded endonuclease site (**I-CsmI**), classified in class 435, subclass 325.
 - IV. Claims 23-34, 36-37, drawn to a recombinant mammalian chromosome and cells comprising a Group I intron encoded endonuclease site (**I-PanI**), classified in class 435, subclass 325.
 - V. Claims 23-37, drawn to a recombinant plant chromosome and cells comprising a Group I intron encoded endonuclease site (**I-SceI**), classified in class 435, subclass 410.
 - VI. Claims 23-34, 36-37, drawn to a recombinant plant chromosome and cells comprising a Group I intron encoded endonuclease site (**I-SceIV**), classified in class 435, subclass 410.
 - VII. Claims 23-34, 36-37, drawn to a recombinant plant chromosome and cells comprising a Group I intron encoded endonuclease site (**I-CsmI**), classified in class 435, subclass 410.

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- VIII. Claims 23-34, 36-37, drawn to a recombinant plant chromosome and cells comprising a Group I intron encoded endonuclease site (**I-PanI**), classified in class 435, subclass 410.
- IX. Claims 38-44, drawn to a recombinant retroviral vector comprising a HO and Group I intron encoded endonuclease site (**I-SceI**), classified in class 435, subclass 320.1.
- X. Claims 38-42, drawn to a recombinant recombinant retroviral vector comprising a HO and Group I intron encoded endonuclease site (**I-SceIV**), classified in class 435, subclass 320.1.
- XI. Claims 38-42, drawn to a recombinant recombinant retroviral vector comprising a HO and Group I intron encoded endonuclease site (**I-CsmI**), classified in class 435, subclass 320.1.
- XII. Claims 38-42, drawn to a recombinant retroviral vector comprising a HO and Group I intron encoded endonuclease site (**I-PanI**), classified in class 435, subclass 320.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I to XII are distinct. Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP ' 806.04, MPEP ' 808.01). In the instant case the **I-SceI**, **I-SceIV**, **I-CsmI** and **I-PanI** are structurally and functionally distinct endonucleases, which have structurally divergent sites of action and result in structurally distinct nucleic acid cleavages. Furthermore, the genetically engineered plant and mammalian chromosomes and cells are distinct because they are classified in different subclasses. In addition, the recombinant chromosome, and the retroviral vectors encoding I-SceI are structurally and functionally different products. For example, the retroviral vectors deliver the encoded gene by infecting cells, whereas delivery of an artificial chromosome requires the transfection of recombinant

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chromosome. The method of making recombinant chromosome and retroviral vectors are distinct. Thus, these inventions are distinct and are of separate use.

Claims 23-27, 29-34 and 36-37 are generic to Group I-VIII because they encompass multiple inventions. Should any group I-VIII elected, claims 23-27, 29-34 and 36-37 will be examined to the extent that they encompasses the elected subject matter. Similarly, claims 33-42 and 44 are generic to Groups IX -XII VIII because they encompass multiple inventions. Should any group IX-XII elected, claims 33-42 and 44 will be examined to the extent that they encompass the elected subject matter.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and the search required for Groups I-IV and V-VIII is not required for Group IX-XII or vice versa, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is (703) 305-6838. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Deborah Clark can be reached on (703) 305-4051. The fax-phone number for the organization where this application or proceeding is assigned as (703) 308-4242. Any inquiry of a general nature or

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relating to the status of this application or proceeding should be directed to the patent analyst Tracey Johnson, whose telephone number is (703) 308-0377. If the claims are amended canceled and/or added the applicants are advised to follow Amendment Practice under § 1.121 (<http://www.uspto.gov>).

S. Kaushal, AU 1633


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